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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

CHOW, MING

ART UNIT

PAPER NUMBER

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/233,475	Applicant(s) WAKABAYASHI, KUNIIHIKO	
	Examiner Ming Chow	Art Unit 2645	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) ____ is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____. | 6) <input type="checkbox"/> Other: |

Final Detail Action

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1 –16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hyde-Thomson (US-PAT-NO: 5,557,659).

For claims 1-2 and 11-12, regarding a memory to store received digitized voice from a sender, Hyde-Thomson teaches on Column 6 Line 1, the file server provides disk for storage and, on Column 11 Line 4, the voice files are stored on the file server. The disk of Hyde-Thomson is the claimed “memory”. Hyde-Thomson also teaches on Column 3 Line 64 writes the digitized voice data onto the file server. The “digitized voice” of Hyde-Thomson is the claimed “digitized voice”. Regarding an identifier to identify a sender number corresponding to the sender that has sent the digitized voice, Hyde-Thomson teaches on items 1601, 1608, and 1613 of FIG. 16 when the original sender is known (“yes” to item 1601 of FIG. 16) the name of sender is found from user table (item 1608 of FIG. 16) and then send the message to its destination (item 1613 of FIG. 16). It is inherent that the system must identify the sender number for sending the message. Regarding a table that provides a correspondence between a plurality of e-mail address and a

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plurality of sender numbers respectively, Hyde-Thomson teaches on Column 18 Line 50 generating a single directory which contains a plurality of E-mail address and extension numbers. The "directory" of Hyde-Thomson is the claimed "table". The "extension numbers" of Hyde-Thomson is the claimed sender numbers. Hyde-Thomson failed to teach the identifier performs an identification of the sender number based on a memory address within the memory in which the digitized voice is stored. However, it is inherent that a computer system must access all data (claimed sender number) on the memory based on a memory address.

Regarding claims 3 and 4, Hyde-Thomson teaches on Column 6 Line 24 that once the analog voice signals are converted to digital signals it will be stored on the memory as claim 1 described. The "stored digitized signals" is a digitized document in the memory.

Regarding claims 5-6 and 13-14, Hyde-Thomson teaches on FIG. 10 and Column 14 Line 3 when replying to a message, the MAPILogon subroutine is used to transmit the reply messages including digitized document and voice.

Regarding claims 7-10 and 15-16, Hyde-Thomson teaches on Column 6 Line 24 and FIG. 16 that the voice processing cards convert analog voice signals to digital signals and transmit the digitized document to the sender.

Response to Arguments

2. Applicant's arguments filed on 6-11-2002 have been fully considered but they are not persuasive.

The Response and Argument:

a) Applicant states on Page 6 none of the methods described by Hyde-Thompson is directed to a system or method for determining an identifier of a sender that has sent a digitized message, and, based on the identifier, to allow a receiver of the digitized message to respond to the sender via an e-mail, whereby the e-mail is sent to an address that corresponds to the sender of the digitized message.

Response: Hyde-Thomson teaches on items 1601, 1608, and 1613 of FIG. 16 when the original sender is known ("yes" to item 1601 of FIG. 16) the name of sender is found from user table (item 1608 of FIG. 16) and then send the message to its destination (item 1613 of FIG. 16). Hyde-Thomson also teaches on Column 18 Line 50 generating a single directory which contains a plurality of E-mail address and extension numbers of the sender. Therefore, the e-mail is sent to an address that corresponds to the sender of the digitized message. The original message sender becomes to be a recipient when the original message recipient replies the message. It is obvious to one skill in the art to apply the user table to identify the sender (of original message) e-mail address for message reply.

b) Applicant states on Page 6 in col. 10, line 63 of Hyde-Thompson, a voice gateway PC scans an e-mail directory and builds a table, which can be searched using the voice mailbox or extension number to determine an e-mail identification called e-mail name. This correspondence table is with respect to the receiver's extension number and e-mail address, and is not directed to the sender's extension number and e-mail address.

Response: The motivation of identifying receiver's extension number and e-mail address in the correspondence is to forward the message. It is obvious to one skilled in the art to adopt the receiver's table and include sender's number and e-mail address for replying messages. Hyde-Thompson also teaches on Column 13 Line 7 he will appear as the originator of the message. Therefore, the caller of original message becomes to be a receiver. Also, Hyde-Thompson suggests on Table 1 Page 9 the sender's name, e-mail address, and phone number.

c) Applicant states on Page 6 in column 2, line 46 Hyde-Thompson merely describes a file server on a LAN that is used as a "post office" for mail messages. The file server is used to provide a mapping for destination phone numbers and their respective e-mail address, and is not used to provide any mapping for sender phone numbers and their respective e-mail addresses.

Response: The motivation of mapping receiver's extension number and e-mail address in the correspondence is to forward the message. It is obvious to one skilled in the art to adopt the receiver's table and include sender's number and e-mail address for replying messages. Also, Hyde-Thompson teaches on Column 2 Line 49 it has information such as

each user's E-mail addresses. The "each user" of Hyde-Thompson can be either the sender or the recipient.

d) Applicant states on Page 6 Figure 7 of Hyde-Thompson describes a method for a user to send a message to another user over the phone, whereby a computer system locates the recipient e-mail name from a stored user table in step 703. However, in the method described in Figure 7 of Hyde-Thompson, the sender initiates an action to send a voice message, via an e-mail attachment, to a receiver or destination. This is different from the present invention in which a recipient receives a voice mail, whereby a sender number of the sender that sent the voice mail is determined and then matched up with an e-mail of the sender, and whereby the recipient can then respond to the voice mail by sending an e-mail to the sender. Applicant also states on Page 7 based on the voice mailbox of the recipient, as given in step 701, the system determines a corresponding e-mail address of the recipient. In the present invention, on the contrary, a sender number identifier attached to a received voice mail is identified by a Sender Number Identifier 26 shown in Figure 1 of the drawing, for example, whereby the sender number identifier is utilized in a Table 25 to see if a corresponding e-mail address of the sender exists in the system.

Response: Hyde-Thompson teaches on item 1607 of FIG. 16 find sender name from user table for replying a message. It is obvious for one skilled in the art to include sender's e-mail address in the user table so that the recipient can reply with an e-mail. See also examiner's response for item a).

e) Applicant states on Page 7 Hyde-Thompson provides a call answering operation scheme, whereby the scheme looks for a caller's name from a user table. However, in Figure 8 of Hyde-Thompson, if a caller is outside of the PBX, then an e-mail message is sent to the recipient of the call, whereby the a default name such as "External" and password are used to signify the originator of the message. Unlike the present invention the recipient cannot REPLY to such an e-mail since the default name of the e-mail message is not a true e-mail address.

Response: Hyde-Thompson teaches on items 1603 and 1604 of FIG. 16 to find user name. If an invalid mailbox number was entered at item 1603 the process will proceed to item 1605 and repeat from 1602. The caller (recipient of original message) cannot reply to the original message caller.

f) Applicant states on Page 7 with respect to col. 13, line 53 and Figure 10 of Hyde-Thompson, this portion of Hyde-Thompson describes how to reply to a message during message playback. Steps 1009 and 1010 use message application program interfaces (MAPIs) to send an e-mail to the recipient. However, to determine the sender's information, the caller has to enter a digital mailbox number of the recipient, whereby the recipient is the original sender. See steps 1002 and 1003 and 1004 of Figure 10 of Hyde-Thompson. This is much different from the present invention whereby a Sender Number Identifier automatically identifies a sender number attached to a receive device message. Applicant also states on Page 8 in Hyde-Thompson, on the contrary, user interaction is

needed, whereby the user has to provide information as to the recipient of an e-mail to an original sender in a case where the original sender is unknown. Referring back to Figure 8 and to col. 8, lines 9-34 of Hyde-Thompson, only original senders in the same PBX as the original recipient are capable of being identified without user input, whereby in the present invention all incoming voice mails are capable of being identified by way of a Sender Number Identifier. Applicant further states on Page 8 similarly, Figure 16 of Hyde-Thompson describes similar features to those discussed above with respect to Figure 10 of Hyde-Thompson, and thus this portion of Hyde-Thompson is also not pertinent to the present invention.

Response: Hyde-Thompson teaches user interaction to obtain original sender number when it is unknown. The sender number is provided with the sender's message and can only be identified when it is provided. The present invention does not support the limitation how the Sender Number Identifier identifies the sender number when the sender number is not provided by the message.

g) Applicant states on Page 8 col. 18, line 50 of Hyde-Thompson in part of its claim 1, whereby this method provides a single directory that contains e-mail addresses and extension numbers, but where the single directory is used to forward a voice message to a called party's extension number and to an e-mail address that also corresponds to a user of the called party extension number. This claim of Hyde-Thompson has nothing at all to do with a recipient (or called party) being able to respond to a call by way of an e-mail of sender (or calling party).

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Response: Hyde-Thompson teaches on Column 18 Line 50 generating a single directory which contains a plurality of E-mail address. It teaches the E-mail address is available in the directory for the recipient (or called party) to respond an e-mail to the sender (or calling party). The ability of responding an e-mail to the sender by the recipient has been cited in previous responses (see FIG. 16 of Hyde-Thompson).

Conclusion

3. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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3. Any inquiry concerning this application and office action should be directed to the examiner Ming Chow whose telephone number is (703) 305-4817. The examiner can normally be reached on Monday through Friday from 8:30 am to 5 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang, can be reached on (703) 305-4895. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Customer Service whose telephone number is (703) 306-0377. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

Or, faxed to TC2600's Customer Service FAX number 703-872-9314

Patent Examiner

Art Unit 2645

Ming Chow

(m)

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PRIMARY EXAMINER
for
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